The Manual of Patent Examining Procedure (MPEP), Eight Edition, August 2001, §706.02(j), states as follows with regard to the burden that the Examiner must meet in order to establish a proper §103(a) rejection:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the Examiner has failed to meet one or more of the above-noted basic criteria, and a proper *prima facie* case of obviousness has therefore not been established. More specifically, Applicant submits that the Mackintosh and Cluts references, even if assumed to be combinable, fail to "teach or suggest all the claim limitations." Further, Applicant submits that there is insufficient motivation to combine Mackintosh and Cluts, or to modify their collective teachings to meet the claim limitations.

With regard to independent claim 1, this claim specifically includes at least the following limitations:

> (i) identification information is extracted from a wireless broadcast in response to a command entered at a wireless receiver, the identification information being extracted and stored without requiring any connection between the wireless receiver and an access point of a data network; and
>
> (ii) the extracted identification information is subsequently delivered over the data network to a server for processing.

Assuming initially for purposes of argument that the Mackintosh and Cluts references are combinable in the manner urged by the Examiner, their combined teachings nonetheless fail to teach or suggest at least limitations (i) and (ii) above.

The Mackintosh reference generally describes techniques for delivery of music over a data network such as the Internet, wherein a listener "receives the broadcast material and the program data via the Internet connection and plays it on his or her computer, workstation or other Internet terminal" (Mackintosh, column 3, lines 17-18). Similarly, Cluts is directed to an interactive network which provides music to subscribers. As stated in Cluts, "[e]ach consumer within a neighborhood node of the consumer system 14 is connected to the distribution network 16 via a subscriber drop cable 46 . . . connected to a set-top terminal 48 or set-top box . . . [which] allows the consumer to (1) receive program modules and programming information distributed by the headend system 12 and to (2) transmit requests or instructions to the headend system 12" (Cluts, column 8, lines 37-49). Therefore, both Mackintosh and Cluts require connection to a data network, such as the Internet or other distribution network, for extraction of identification information in response to a user command. Neither Mackintosh nor Cluts teach or suggest an arrangement in which identification information is extracted from a wireless broadcast in response to a user command entered at a wireless receiver, with the identification information being extracted and stored without requiring any connection between the wireless receiver and an access point of a data network, and the extracted identification information being subsequently delivered over the data network to a server for processing.

The Examiner in formulating the §103(a) rejection of claim 1 argues that limitation (i) above is met by column 8, lines 41-50 and column 9, lines 19-33 of Mackintosh (Office Action, page 2, section 2). Applicant respectfully disagrees. These cited portions of Mackintosh provide as follows, with emphasis supplied:

> In a step 222, radio station 204 provides its broadcast materials to a broadcast Internet service provider 208. In one embodiment, the materials provided to broadcast Internet service provider 208 can include the actual radio broadcast from radio station 204 as well as event codes indicating current tracks in that broadcast, current advertising in that broadcast,

or other data associated with the real time broadcast. In one embodiment, these signals can be broadcast via an AM or FM radio link to broadcast Internet service provider 208.

. . .

The cut number can be a numeric or alphanumeric identification (ID) that identifies the particular cut. The category of the cut can include, for example, an identification of the type of cut to which the cut number or program data refers. For example, the cut category may differentiate between music, ad traffic, DJ segments, and link promos. Other or additional categories can be included as well.

Additionally, information pertaining to the format of the cut can be included as well. Such format information can further indicate a type of music (e.g., pop, rock, jazz, classical, country and western, etc.), or a type or category of product being advertised (e.g., clothing, food and beverage, insurance, automobile services, etc.). This format information can be used to key particular pieces or categories of supplemental material to the broadcast.

There is no teaching or suggestion in these cited portions of Mackintosh, relied upon by the Examiner, regarding limitation (i) above. For example, there is no teaching or suggestion that identification information may be extracted from a wireless broadcast in response to a command entered at a wireless receiver by a user to whom the broadcast is being presented in perceptible form. Instead, the cited portion indicates that "radio station 204 provides its broadcast materials to a broadcast Internet service provider 208."

The broadcast Internet service provider 208 in Mackintosh is not a user, to whom the broadcast is presented, that enters a command for extraction of identification information from the broadcast, as specified in conjunction with limitation (i) above. Broadcast Internet service provider 208 is simply an intermediary between radio station 204 and Internet-based users to whom the broadcast will be presented via the Internet, as illustrated in FIG. 5 and described at column 9, lines 49-60.

Moreover, the identification information cannot be extracted and stored without requiring any connection between the wireless receiver and an access point of a data network, since in FIG. 5 of Mackintosh the user terminal 212 remains connected to the Internet for the entire period of time

for which the user desires to receive the broadcast from broadcast Internet service provider 208. Applicant therefore submits that the Mackintosh reference fails to provide any relevant teachings regarding limitation (i) above.

The Examiner acknowledges that limitation (ii) is not taught or suggested by Mackintosh, but argues that Cluts in column 6, lines 1-10 and column 15, lines 14-25 teaches this limitation (Office Action, page 2, last paragraph to page 3, first paragraph). These cited portions of the Cluts reference provide as follows:

> The headend receives satellite-delivered video and audio programming, over-the-air broadcast television station signals, and network feeds delivered by terrestrial microwave and other communication systems. In addition, headends may inject local broadcast programming into the package of signals sent to subscribers, such as commercials and live programs created in a television studio.
>
> The "distribution system" carries the signals from the headend to a number of distribution points in a community and, in turn, distributes the these signals to individual neighborhoods for delivery to subscribers.
>
> . . .
>
> In the preferred system, the each song has a song identification (ID) number that uniquely identifies that song. Similarly, each artist is identified by a unique artist ID number. The digital audio data is stored on a continuous media server by song ID number. The associated administrative information is stored on an administrative server. The administrative information includes the style tables, information for each song (title, artist, album, etc.), and all of the other databases, graphics, text, etc. that are required by the audio on demand system. A playlist is created by creating a database that includes the song ID numbers of the songs that are included in the playlist.

Applicant submits that there is no teaching in the above-cited portion regarding limitation (ii) of claim 1, that is, delivery of identification information extracted from a wireless broadcast over a data network to a server for processing.

The Mackintosh and Cluts references thus collectively fail to teach or suggest at least limitations (i) and (ii) of claim 1.

Applicant further submits that the Mackintosh and Cluts references are not combinable in the manner urged by the Examiner.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 3, second paragraph, the Examiner provides the following statement to prove motivation to combine the Mackintosh and Cluts references, with emphasis supplied:

> It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a delivery of extracted information over a network to a server and to identify at least one delivered information as taught by Cluts in the method [of] Mackintosh to reduce the latency and make the method more versatile.

Applicant submits that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

In addition, the Examiner fails to acknowledge the specific teaching away from the claimed invention that is inherent in the system shown in FIG. 5 of Mackintosh. As Applicant pointed out above, in FIG. 5 of Mackintosh the user terminal 212 remains connected to the Internet for the entire period of time for which the user desires to receive the broadcast from broadcast Internet service provider 208. Therefore, the identification information cannot be extracted and stored without

requiring any connection between the wireless receiver and an access point of a data network, in accordance with limitation (i) of claim 1. Therefore, one would not be motivated to modify Mackintosh in the manner urged by the Examiner, since such a modification could well result in rendering the Mackintosh system unusable for its intended purpose.

It is therefore believed that a *prima facie* case of obviousness has not been established for independent claim 1.

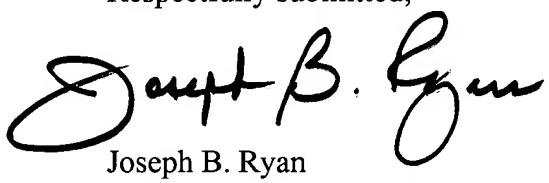
Independent claims 12 and 23 each include limitations similar to (i) and (ii) above, and are therefore believed allowable for substantially the reasons identified above with regard to independent claim 1.

Dependent claims 2-11 and 13-22 are believed allowable for at least the reasons identified above with regard to their respective independent claims.

Accordingly, it is believed that claims 1-23 are patentably distinct over the art of record and are in condition for allowance.

As indicated above, a Notice of Appeal is submitted concurrently herewith.

Respectfully submitted,



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Enclosure(s): Notice of Appeal